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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,580	05/17/2002	Hidetoshi Sugiyama	ASA-1069	3826
24956	7590	11/01/2006		
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				
			EXAMINER LEVKOVICH, NATALIA A	
			ART UNIT 1743	PAPER NUMBER

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/069,580	SUGIYAMA ET AL.	
	Examiner	Art Unit	
	Natalia Levkovich	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-34 and 37-38 is/are pending in the application.
- 4a) Of the above claim(s) 29-34, 37 and 38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 17-22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 29-34, 37 and 38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and remarks dated 08/10/2006 have been acknowledged by the Examiner.

Election/Restrictions

2. Newly submitted claims 37-38 and the amended claims 29-34 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

- claims 17-28 (invention I), are drawn to an automatic analyzer;
- claims 29-34 (invention II), as amended, are drawn to a part feeding device, and
- claims 37-38 (invention III), are drawn to a method of controlling an automatic analyzer.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the analyzer, as claimed, does not require the particulars of the part feeding device, such as, for example,

Art Unit: 1743

the controller configured for 'determining a quantity of part racks'. The subcombination has separate utility, such as, for example, a loader.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used with different methods, for example, with a method including the steps of sensing the lowermost item of the rack, or involving a recovery lifter. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-34 and 37-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

4. Claim 20 rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 20, lines 4-6, lifters 'extending outward from' a belt, is unclear.

Claim Rejections - 35 USC § 102

5. The 35 U.S.C. 102(b) rejection of claim 17, as being anticipated by Miura et al. (US 5190434), is withdrawn in view of the latest amendments.

Claim Rejections - 35 USC § 103

6. Claims 17-20, 22, 24-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura.

As was previously discussed in the prior Office Actions, Miura discloses an article supplier comprising a “first elevator for supplying articles [‘supply lifter’ – Ex.] contained in a pallet to a robot [‘rack separator’ – Ex.], a second elevator [‘recovery lifter’ – Ex.] for discharging an empty pallet, and a driving mechanism with a motor and a belt coupled to the first and second elevators -(Abstract). As shown in Figure 7A, the elevators are disposed on the bottom surface of the body 102 equipped with four casters 110 [‘movable table’ – Ex.].

Referring to claims 17, 20, 26 and 28, Miura does not teach the arrangement of two motors and two belts.. However, Miura does teach, as shown in Figure 1, motor 8 connected to timing belt 9 for driving elevators 3 and 4 upwardly and downwardly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed motors and belts dedicated to each elevator, while arranging them in a compact and accessible

Art Unit: 1743

manner, in the modified apparatus of Miura, in order to obtain more flexibility in controlling the elevators.

With respect to claims 18, 19 and 24, Miura does not teach a controller configured to determine a quantity of racks remaining on the supply elevator. However, Miura does teach a controller linked to counters / position sensors configured to count the number of articles remaining in the pallet ['rack' – Ex.] – (see Col.6, line5; Col.9, lines 15-20). If the sensors determine that the pallet is empty, "the controller 30 outputs a stop signal ['alarm means' – Ex.] for the motor", to interrupt operation (Col.8, lines 10-15). The apparatus also includes display 20 (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have configured the controller such as to count not only the number of articles on the rack, but also the number of racks, in the modified apparatus of Miura, in order to provide smooth supply / removal of the racks.

7. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura in view of Farber et al. (US 4856073).

Miura does not teach a lift housing having a door which can be automatically locked to prevent an access to the lifters during the time of operation. However, this feature is very well known and used not only in regular elevators, but also in the art. For example Farber discloses an apparatus comprising, as illustrated in Figure 1, chamber 13 which includes elevator 27, slots ['racks' - Ex.] 25 and an access door (not shown). "All doors of apparatus 11 are normally locked and are under the control of controlling unit 73...the

Art Unit: 1743

software of unite 73, prevents operator errors such as the insertion of a carrier into a slot whose occupant is at the inspection station, the changing of a reagent which is about to be dispensed, or the removing of the waste bin(biohazard bag) at a point when a carrier is about to be discarded" (Col.11, lines 5 and 15-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a lift housing with a part introducing door locked during the lift operations in the modified apparatus of Miura, in order to provide security of the rack handling.

Allowable Subject Matter

8. Claim 23 is allowed.

The prior art fails to teach, or fairly suggest the specifics of the controller configured to determine whether or not the uppermost rack 'has been properly separated and whether to continue or interrupt the operation, the determination being made based on the information received from the position sensors arranged in the particular manner, as recited in claim 23.

Response to Arguments

9. Applicant's arguments dated 08/10/2006 have been fully considered but they are not persuasive and moot in view of new grounds of rejection.

Applicant argues that 'Farber fails to teach that a controller means locks the door when the lifters are in use, but enables the door to be opened for replacing part racks when the lifters are in an inactive position even while the analyzer is able to continue operation. This feature of the invention enables continuous operation of the analyzer and thereby reduces downtime. There is no teaching or motivation for a person skilled in the art to combine the teachings of Miura and Farber...' Examiner notes that Farber was cited to support the idea of locking elevators. It was also noted that locking elevators during operation and unlocking them when they stop, is very well known. For example, regular elevators operate in this manner. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a lift housing with a part introducing door locked during the lift operations in the modified apparatus of Miura, in order to provide security of the rack handling.

1. Applicant argues that 'while Miura is configured to count the articles remaining on a pallet, this is not relevant or analogous to determining the quantity of racks remaining on the supply lifter'. Examiner disagrees. Counting is a process of manipulating abstract numbers, not objects, and will be the same for counting either articles or racks. Additionally, it would have been clearly within the skill of an artisan at the time the invention was made, to configure the controller such that alarm sounds before the counted number becomes zero, in order to provide continuous supply.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Technology Center 1700